

Remarks

This Response and Amendment addresses the Office Action mailed July 24, 2003.

Claims 15-19 and 21-33 are now pending.

Claims 21 and 23 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 15, 21, and 23 have been editorially amended to address this rejection. Claim 27 has been similarly amended. Applicant respectfully request that this rejection be withdrawn.

Claims 15-19 and 21-33 have been rejected under 35 U.S.C. §103(a) for obviousness over various references. A rejection under 103(a) must provide a prima facie case of obviousness, which has four parts:

- a. There must be some suggestion or motivation to combine the prior art.
- b. There must be a reasonable expectation of success of the combination.
- c. The prior art references, when combined, must teach or suggest all claim limitations.
- d. Both the teaching or suggestion to make the combination and the reasonable expectation of success must be found in the prior art, and not in the applicant's disclosure. MPEP 2142; In re Vaeck, 947 F.2d. 488, 493 (Fed. Cir. 1991).

None of the three rejections in the Office Action meet all four prongs of this test. Therefore, they should be withdrawn. Applicant respectfully traverses each rejection.

Rejections Over Kimura In View of Barnes and Tupper

Claims 15-18, 21-23, 26-31, and 33 were rejected as being unpatentable over U.S. Patent No. 5,553,735 to Kimura ("Kimura") in view of U.S. Patent No. 5,674,546 to Barnes et al. ("Barnes") and U.S. Patent No. 2,802,590 to Tupper ("Tupper").

Claim 15 teaches a decorative container system for displaying items in a hollow region comprising a decorative container with a hollow region between an outer container and an inner container, a removable member allowing access to the hollow region and a decorative lid shaped to be removably mounted in an upper opening of the decorative container. The outer container of claim 15 is at least partially transparent.

Kimura relates to a drinking vessel for holding a liquid including an outer shell and an inner shell, forming a cavity between the two shells. (Kimura, Abstract.) As acknowledged in the Office Action, Kimura does not show a decorative lid. Barnes discloses a package for selling

omelet ingredients that can also be used for cooking the omelet in a microwave oven. Tupper discloses a waste can with a cover that has a region for receiving deodorant tablets. The Office Action argues that the upper container 10 of Barnes that holds omelet filling ingredients teaches a decorative lid, and argues that it would have been obvious to add the upper container 10 of Barnes to the container of Kimura. The Office Action further argues that it would be obvious to combine the cover for the waste can shown in Tupper with the upper container 10 of Barnes to obtain a removable and replaceable lid access member.

Applicant respectfully traverses this rejection and reasoning. First, the references are non-analogous and it would not be obvious to one of skill in the art to combine them. Second, there is no motivation found in the prior art for combining the drinking glass of Kimura with the upper container having a cavity for omelet ingredients of Barnes and the waste can of Tupper.

This combination would not be obvious to one of skill in the art because the vessel of Kimura is a reusable drinking glass while Barnes describes an omelet cooking container for one-time use that makes omelets a more convenient food to cook in the microwave. The Kimura drinking vessel is preferably made of plastic injection molded material, and is washable and reusable. (See Kimura, Col. 2, lines 43-47.) The omelet cooking container of Barnes on the other hand is designed for one-time use and is made of disposable materials like paperboard, paperboard-polymer laminates, foamed plastic, or polystyrene that are not suited for washing and reuse. (Barnes, Col. 6, lines 11-24.) The upper container 10 of Barnes is clearly designed for one-time use as it is closed with a sealing foil 16 that is adhered to the upper sealing flange of the upper container 10 with an adhesive releasable seal. Because Kimura describes a washable drinking glass while Barnes describes a disposable microwave-cooking container for one-time use, it would not be obvious to combine Kimura and Barnes.

Moreover, the combination of Tupper with either Kimura or Barnes would not be obvious to one of ordinary skill in the art. Tupper is not directed to a decorative container system as claimed, but rather to a waste can with a means of deodorizing the odors present in the waste can. Tupper's deodorized waste can and Barnes' one-time use omelet cooker are so different and serve such different purposes that one of ordinary skill in the art would not seek to combine these references.

In addition, there is no motivation to combine the references found in the prior art. The Examiner argues that it would have been obvious to add the upper container of Barnes to the vessel of Kimura in order to "close the container and seal the contents from contamination." While it is not uncommon for drinking vessels to be provided with lids, the Examiner has not presented any motivation for adding an upper container having a cavity to a drinking vessel.

As for Barnes, the upper container 10 of Barnes holds the omelet inlay ingredients in a separate container from the liquid egg for the omelet. The purpose of the cavity of the upper container 10 is to hold the omelet inlay ingredients, and the presence of the cavity does not contribute to sealing the lower container or sealing it from contamination. The Examiner has presented no motivation found in the prior art for modifying the drinking vessel of Kimura to add an upper container with a cavity.

Tupper does not remedy this deficiency. Tupper discloses a cover for a waste can with a capacity to hold a deodorizer. There would be no reason to combine a holding capacity in the lid of a drinking vessel, and especially not a deodorizing element as provided in the waste can of Tupper. Accordingly, there would be no reason to combine Kimura with Tupper to provide a drinking vessel with an upper container having a cavity.

For these reasons, claim 15 is patentable over Kimura in view of Barnes and Tupper. Therefore, dependent claims 16-18, 21-23, and 26 are also patentable for at least the same reasons.

Independent claim 27 also recites the features described above with respect to claim 15. Accordingly, claim 27 and claims 28-31 and 33, which depend from claim 27, are also believed allowable.

In addition, claims 15-19, 21-26, and 28 are even further removed from the cited references as those claims include the feature of a removable and replaceable lid access member. The Examiner also asserts that it would be obvious to combine Barnes with Tupper to obtain a replaceable lid access member in order to "change the contents and store a refreshed supply of items in the hollow lid cavity." However, because Barnes is a one-time use omelet cooker, there would be no reason to modify it so that the lid is replaceable. The one-time use lid in Barnes is

not intended to be reused. Therefore, there is no motivation to combine Barnes with Tupper in the manner suggested by the Examiner.

Rejections Over Kimura In View of Barnes, Tupper, and Yellin

Claims 19, 24, 25, and 32 were rejected as being unpatentable over Kimura in view of Barnes, Tupper, and U.S. Patent No. 3,992,811 to Yellin ("Yellin"). Applicant traverses this rejection.

The Office Action states that the combination of Kimura, Barnes, and Tupper is the same as taught in the first rejection, discussed above, and that Yellin is relied upon to teach the dividers of claims 19, 24, 25, and 32. As argued above, the combination of Kimura, Barnes, and Tupper is not obvious, so this rejection should be withdrawn for at least the same reasons as discussed above.

Rejections Over Gallegos In View of Barnes and Tupper

Claims 15-18, 21, 22, 26-31, and 33 were rejected as being unpatentable over U.S. Patent No. 5,275,277 to Gallegos ("Gallegos") in view of Barnes and Tupper. Applicant traverses this rejection.

Gallegos discloses a novelty drinking glass. The Office Action argues that Gallegos teaches the invention except for the decorative lid. The Office Action argues that it would have been obvious to modify Gallegos to add the upper container of Barnes and Tupper in order to "close the container and seal the contents from contamination." Applicant respectfully traverses this rejection. This rejection is not proper for the same reasons that the rejection over Kimura, Barnes, and Tupper is not proper:

1. The references are non-analogous and it would not be obvious to one of skill in the art to combine them.
2. There is no motivation found in the prior art for combining the drinking glass of Gallegos with the upper container having a cavity of Barnes.

3. There is no motivation to modify the upper container of the Barnes/Gallegos combination to have the replaceable lid access member of Tupper because Barnes is disposable.

This combination would not be obvious to one of skill in the art because, similar to the drinking vessel of Kimura, the drinking glass of Gallegos is a reusable drinking glass while Barnes describes an omelet cooking container for one-time use that makes omelets a more convenient food to cook in the microwave. The Gallegos drinking glass is preferably reusable and of "durable and reliable construction." (See Gallegos, Col. 2, lines 35-37.) The omelet cooking container of Barnes on the other hand is designed for one-time use and is made of disposable materials, as discussed above. (Barnes, Col. 6, lines 11-24.) Because Gallegos describes a durable, reusable drinking glass while Barnes describes a microwave-cooking container for one-time use, it would not be obvious to combine Gallegos and Barnes.

Moreover, the combination of Tupper with either Gallegos or Barnes would not be obvious to one of ordinary skill in the art. Tupper is not directed to a decorative container system as claimed, but rather to a waste can with a means of deodorizing the odors present in the waste can. Nor would there be any motivation to alter Gallegos so that a deodorizing chamber is included in a lid to the drinking glass. Also, since waste cans are not generally disposable, there would not be any motivation for combining it with the one-time use omelet cooking container of Barnes.

In addition, there is no motivation to combine Gallegos, Barnes, and Tupper found in the prior art. The Examiner argues that it would have been obvious to add the upper container of Barnes to the glass of Gallegos in order to "close the container and seal the contents from contamination." While it is not uncommon for drinking glasses to be provided with lids, the Examiner has not presented any motivation for adding an upper container having a cavity to a drinking vessel. The upper container 10 of Barnes holds the omelet inlay ingredients in a separate container from the liquid egg for the omelet. The purpose of the cavity of the upper container 10 is to hold the omelet inlay ingredients, and the presence of the cavity does not contribute to sealing the lower container or sealing it from contamination. The Examiner has not presented any motivation found in the prior art for modifying the drinking glass of Gallegos to add the upper container of Barnes, as opposed to a conventional lid.

Tupper does not remedy this deficiency. Tupper discloses a cover for a waste can with a capacity to hold a deodorizer. There would be no reason to combine a holding capacity in the lid of a drinking vessel, and especially not a deodorizing element as provided in the waste can of Tupper. Accordingly, there would be no reason to combine Gallegos with Tupper to provide a drinking vessel with an upper container having a cavity.

For these reasons, claim 15 is patentable over Gallegos in view of Barnes and Tupper. Therefore, dependent claims 16-18, 21, 22, and 26 are also patentable for at least the same reasons.

Independent claim 27 also recites the features described above with respect to claim 15. Accordingly, claim 27 and claims 28-31 and 33, which depend from claim 27, are also believed allowable.

In addition, claims 15-19, 21-26, and 28 are even further removed from the cited references as those claims include the feature of a removable and replaceable lid access member. The Examiner also asserts that it would be obvious to combine Barnes with Tupper to obtain a replaceable lid access member in order to "change the contents and store a refreshed supply of items in the hollow lid cavity." However, because Barnes is a one-time use omelet cooker, there would be no reason to modify it so that the lid is replaceable. The one-time use lid in Barnes is not intended to be reused. Therefore, there is no motivation to combine Barnes with Tupper in the manner suggested by the Examiner.

Rejections Over Gallegos In View of Barnes, Tupper, and Yellin

Claims 19, 24, 25, and 32 were rejected as being unpatentable over Gallegos in view of Barnes, Tupper, and further in view of Yellin. Applicant respectfully traverses this rejection.

The Office Action cites that the combination of Gallegos, Barnes, and Tupper is the same as taught by the rejection identified above. Therefore, this rejection simply addresses the removable dividers of claim 19, 24, 25, and 32 as being taught by Yellin. As argued above, the combination of Gallegos, Barnes, and Tupper is not obvious, so this rejection should be withdrawn for at least the same reasons as discussed above.


Conclusion

In view of the above, favorable reconsideration and Notice of Allowance is requested. The Examiner is invited to telephone the undersigned at (612) 336-4710 if there are any issues that prevent the allowance of this application.

Respectfully submitted,

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